REMARKS

The claims are 1-92 and 107, with claims 1, 45, 64 and 107 being independent. Claims 93-106 have been cancelled. No new matter has been added. Reconsideration of the claims is respectfully requested.

The Examiner has required election of a single disclosed invention for prosecution on the merits in this case. The Examiner alleged the existence of four patentably distinct inventions:

Group I: Claims 1-44 and 64-92, drawn to a method of nucleic acid hybridization, classified in class 435, subclass 6;

Group II: Claim 45-63, drawn to a biological matrix, classified in class 345, subclass 55;

Group III: Claims 93-106, drawn to a detection substrate, classified in class 427, subclass 7; and

Group IV: Claim 107, drawn to a method of preparation of the matrix, classified in class 101, subclass 401.2.

During a telephone interview with the Examiner, Applicants provisionally elected Group III, claims 93-106, with traverse. Applicants hereby again traverse the restriction requirement and respectfully submit that at least the claims of Groups I and III should be examined together.

The Examiner has alleged that the inventions of Groups I and III are independent or distinct, because "the method of nucleic acid hybridization of Group I can be practiced by the biological matrix, and detection substrate of Groups II and III

respectively or can be practiced by solution based hybridization without any substrate or by mass spectroscopy". Applicants respectfully disagree with the Examiner's reasoning.

Independent claims 1 and 64 of Group I clearly specify the use of a substrate in practicing the claimed methods. Further, the Examiner will note that the matrix of Group II also requires the use of a substrate. Thus, it is clear that the method of Group I cannot be literally practiced without a substrate. Accordingly, the Examiner has not provided sufficient reasons for the restriction requirement, as mandated by M.P.E.P. § 816.

The claims of Groups I and III are clearly closely related. Thus, Applicants believe that the search performed by the Examiner with respect to claims 93-106 already includes the subject matter pertaining to the method claims of Group I and this subject matter has been considered by the Examiner in order to evaluate the patentability of the claims of Group III. Therefore, since no additional work or expense is required, even if the restriction requirement is not withdrawn, Applicants' provisional election of Group III should be waived and Applicants should be permitted to shift the examined invention from Group III to Group I under M.P.E.P. § 819.01.

Claims 93, 94, 96, 102 and 103 stand rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by EP 0 373 203 B1 (Southern). Claims 93-97, 102 and 103 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Southern. Claims 93-99, 102 and 103 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Southern in view of U.S. Patent No. 5,688,642 (Chrisey). Claims 93-100, 102 and 103 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Southern in view of Chrisey and further in view of U.S. Patent No. 5,807,942

(Sakaki). Claims 93-97, 102-106 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Southern in view of U.S. Patent No. 5,601,980 (Gordon).

Since claims 93-106 have been cancelled, these rejections are moot and should be withdrawn.

Wherefore, favorable consideration of the claims of Group I is respectfully requested.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our address given below.

Respectfully submitted,

Jason M. Olen
Attorney for Applicants

Registration No. 48,512

FITZPATRICK, CELLA, HARPER & SCINTO
30 Rockefeller Plaza
New York, New York 10112-3801
Facsimile: (212) 218-2200

NY_MAIN 344808v1